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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/711,709      | 11/13/2000  | Moshe Kushnir        | 287985/002          | 7668             |

7590 03/17/2003

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New York, NY 10038

EXAMINER

GEORGE, KONATA M

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1616     | (10)         |

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                 |                |
|------------------------------|-----------------|----------------|
| <b>Office Action Summary</b> | Application No. | Applicant(s)   |
|                              | 09/711,709      | KUSHNIR ET AL. |
| Examiner                     | Art Unit        |                |
| Konata M. George             | 1616            |                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 January 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 10-25 is/are pending in the application.
  - 4a) Of the above claim(s) 14-21 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 10-12 and,22-24 is/are rejected.
- 7) Claim(s) 13 and 25 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 13 November 2000 is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

Claims 10-13 and 22-25 are pending in this application.

### ***Action Summary***

1. Examiner acknowledges the addition of claims 22-25 in the present application.
2. The rejection of claims 11 and 13 under 35 U.S.C. 102(b) as being anticipated by Nakoneczny et al. is hereby withdrawn.
3. The rejection of claims 10 and 12 under 35 U.S.C. 102(b) as being anticipated by Nakoneczny et al. is being maintained for the reasons stated in the previous office action.

### ***Response to Arguments***

4. Applicant's arguments filed January 28, 2003 have been fully considered but they are not persuasive.

Applicants argue that Nakoneczny teaches a wick type liquid dispenser and not a tube to dispense the liquid from the reservoir. It is argued that the driving force for transporting the fluid in the present invention is via relatively wide tubing. It is the position of the examiner that the prior art does teach the claimed invention. The invention is directed to an apparatus comprising a storage compartment and a dermal patch in fluid communication with said storage compartment. There is nothing in the claims that states that the dermal patch is in communication with the storage compartment via relatively wide tubing. Since there is no teaching as to how the patch communicates with the storage compartment then any means of communication (i.e. wick-type) can be used. It is also argued that a thick paste can be dispersed from the

claimed invention and not from the apparatus of Nakoneczny. Applicants' arguments are moot, as the type of liquid of the claimed invention is not claimed.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 22 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakoneczny et al. (US 5,242,111) for the reason set forth in the rejection dated September 24, 2002. Claims 22 and 24 are broader than claims 10 and 12, however, Nakoneczny teaches the claimed apparatus.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakoneczny et al. (US 5,242,111).

Nakoneczny teaches an apparatus comprising a storage compartment that is compressible by mechanical pressure and containing fluid therein, a dermal patch in fluid communication with said storage compartment, having a plurality of hollow

capillaries for flow of said fluid and attached to a portion of skin of a patient and a regulating valve for flow control of fluid from said storage compartment (see figure 15, col. 7, line 53 to col. 8, lines 29; col. 9, lines 45-48; col. 12, lines 31-63 and col. 13, lines 5-17). The prior art does not teach the apparatus having a plurality of hollow capillaries.

Column 12, lines 3-11 teaches that the wick may be of polymer or ceramic material, which would comprise hollow capillaries that carries the liquid. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to realize that the apparatus of Nakoneczny contains hollow capillaries for flow of the fluid to the skin of the patient.

***Allowable Subject Matter***

7. Claims 13 and 25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

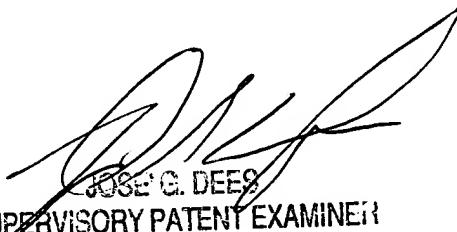
***Telephone Inquiries***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Konata M. George, whose telephone number is (703) 308-4646. The examiner can normally be reached from 8AM to 5:30PM Monday to Thursday, and on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, José Dees, can be reached at (703) 308-4628. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4556 for regular communications and for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Konata M. George

  
JOSÉ G. DEES  
SUPERVISORY PATENT EXAMINER

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